

Attorney Docket No.: 057733-5002
Application No.: 10/081,781
Page 7 of 10

REMARKS

The Office Action dated March 11, 2003 has been reviewed. Claims 1, 3, 7, 13 and 15 have been currently amended, and claims 2, 4-6, 8-12, 14 and 16 remain as originally presented. Thus, claims 1-16 are respectfully submitted for reconsideration by the Examiner.

The drawings were objected to because there were two drawings labeled as Figure 5. This objection is respectfully traversed in view of the attached replacement drawing sheets in which the figures as-originally filed have been renumber sequentially from 1-10.

Claim 15 was objected to because of an informality. This objection is respectfully traversed in view of the above amendment to claim 15, which is in accordance with the Examiner's helpful suggestion. Claims 3 and 13 have been amended to improve the grammatical clarity of these claims, and not for reasons related to patentability.

Claims 1, 2, 4, 5, 7, 8 and 15 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,563,237 to Maxwell. And claims 3, 6, 9-14 and 16 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Maxwell in view of U.S. Patent No. 5,029,481 to Skelton. These rejections are respectfully traversed in view of the above amendments to claims 1 and 7, and further in view of the following comments.

Independent claim 1 recites a combination of features including "end segments folded together in overlapping relationship and interconnected by a stitch to define a tapered, open-ended, thumb-receiving passageway." Thus, the end segments are interconnected in a fixedly manner that is generally permanent such that the end segments cannot become detached. Support for these features may be found in Applicant's specification as originally filed at, for example, page 3, lines 11-12, and page 5, lines 11-12.

In contrast to the present invention, Maxwell shows a distal phalanxes bandage including an adhesive coated strip 10 (column 2, line 2) or a strip 110 with end 116 overlapping end 118 (column 3, lines 18-20). Maxwell is completely silent as to using a stitch to interconnect end segments. Thus, it is respectfully submitted that Maxwell fails to teach each and every element as set forth in claim 1.

As pointed in out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully request that the

Attorney Docket No.: 057733-5002
Application No.: 10/081,781
Page 8 of 10

rejection of claims 1 and 15 under 35 U.S.C. § 102(b) be withdrawn for at least the above reasons. Moreover, claims 2, 4 and 5 depend from claim 1 and recite that same combination of allowable features as well as additional features that further distinguish the present invention over Maxwell.

Independent claims 7 and 15 recite combinations of features that each include end portions that "are oriented relative to one another in an oppositely inclined relationship" (claim 7) or "end segments being folded together in oppositely inclined overlapping relationship" (claim 15). Thus, the end segments approach one another oppositely and from a relatively inclined relationship. Support for these features may be found in Applicant's specification as originally filed at, for example, page 5, lines 3-5 and 14-16.

In contrast to the present invention, Maxwell shows a distal phalanxes bandage with ends 16,18 (Figures 1 and 2) or 116,118 (Figures 3 and 4) that overlap one another "so that the strip assumes a configuration of the frustum of a cone" (column 2, lines 18-20). Maxwell specifically teaches a configuration that is not consistent with the present invention. Thus, it is respectfully submitted that Maxwell fails to teach each and every element as set forth in claims 7 and 15.

Again, as pointed in out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully request that the rejection to claims 7 and 15 under 35 U.S.C. § 102(b) be withdrawn for at least the above reasons. Moreover, claim 8 depends from claim 7 and recites that same combination of allowable features as well as additional features that further distinguish the present invention over Maxwell.

Similar to claims 7 and 15, independent claim 10 recites a combination of features including "oppositely inclined, overlapping, interconnected end segments," and independent claim 16 recites a combination of features including "end segments being folded together in oppositely inclined overlapping relationship and interconnected." For the same reasons as discussed above, Maxwell fails to teach at least these features.

Skelton is cited in the Office Action as allegedly suggesting "a method of holding a bucket 14 with a user's thumb positioned adjacent a bail portion 12 and the fingers engaging the bucket as shown in Figure 2." Nevertheless, Skelton fails to suggest the "oppositely inclined" relationship of end segments, as recited in Applicant's claim 10, and therefore fails to overcome

Attorney Docket No.: 057733-5002
Application No.: 10/081,781
Page 9 of 10

the aforementioned deficiencies of Maxwell. In fact, Skelton teaches a method whereby a loop encompasses both a user's thumb and the swing handle of a bucket. As such, Skelton teaches a contrasting method wherein a tension force, as opposed to a compression force in the present invention, exists between a thumb and a swing handle.

MPEP § 2143.03 points out that "[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Therefore, Applicant respectfully requests that the rejection of claims 10 and 16 under 35 U.S.C. § 103(a) be withdrawn. Moreover, claims 3, 6, and 9 depend from independent claim 1, and claims 11-14 depend from independent claim 10, and each of these dependent claims recite the same combination of allowable features as well as additional features that further distinguish the present invention over Maxwell in view of Skelton.

Attorney Docket No.: 057733-5002
Application No.: 10/081,781
Page 10 of 10

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.111 places claims 1-16 in condition for allowance, and Applicant earnestly solicits an early notice of such.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution.

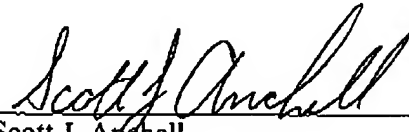
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: 15 October 2003

By:



Scott J. Ansell
Registration No. 35,035

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000

OFFICIAL

RECEIVED
CENTRAL FAX CENTER

OCT 16 2003